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SUGHRUE MION, PLLC				
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ART UNIT		PAPER NUMBER		
3688				
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01/25/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com

PPROCESSING@SUGHRUE.COM

USPTO@SUGHRUE.COM

Office Action Summary

Application No.

10/588,316

Applicant(s)

MIURA ET AL.

Examiner

MIN SHIN

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the amendment filed on 9/28/2009. Claims 1-6 and 19-20 are currently pending and have been considered below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim element "displaying order deciding means, means for calculating, means for recording, etc., " are a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of

ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

4. Further, Claim 5 recites the limitation “said computation” which has insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 5, 6 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least

Gottschalk v. Benson, 409 U.S. 70 (1972); Diamond v. Diehr, 450 U.S. 192 (1981); Parker v. Flook, 437 U.S. 589 n.9 (1978); and Cochrane v. Deener, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (Benson, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (Flook, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, _F.3d_, 2008 WL4757. The claim can be amended to include a particular machine or a device into the explicit steps, **such as selecting and calculating**, that are not insignificant extra-solution activities.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Meisel (US 2003/0033292).

Claim 1:

Meisel discloses an information providing system for providing information responding to a retrieval request from a terminal, characterized in comprising:

a database having information, which an information provider provides, and a bid amount of money of said information stored correspondingly;

a selecting means for responding to the retrieval request from the terminal, selecting m pieces of information, which become candidates for n pieces of information being presented to the terminal, from said database;

a displaying order deciding means for: calculating a sum of bid amounts of money of m pieces of information, calculating a ratio of each of m pieces of information over said sum of bid amounts of money of m pieces of information, and deciding information of which a displaying order is a first rank based upon a probability proportional to magnitude of said ratio of the bid amount of money of each of m pieces of information (paragraph 0019. **One embodiment relates to a system and method to enable a web site promoter to define a search listing for a search result list, select a search term relevant to the promoter's web site, and influence a search result list position for the search listing on an Internet search engine. When an Internet user enters the search terms in a search engine query, the search engine will generate a search result list with the web site promoter's listing in a position influenced by one or more parameters defined by the promoter. The present embodiments further permit web site promoters to select the types of referrals to utilize when selecting search terms for purposes of participating in the search result listings")**

continuously calculating a sum of bid amounts of money of (m-1) pieces of information except the bid amount of money of the information of which the displaying order is a first rank, calculating a ratio of the bid amount of money of each of (m-1) pieces of information over said sum of bid amounts of money of (m-1) pieces of information, and

deciding information of which the displaying order is a second rank based upon a probability proportional to magnitude of said ratio of the bid amount of money of each of $(m-1)$ pieces of information;

said computation is performed until information of which the displaying order is an $(n-1)$ -th rank is decided; and

calculating a sum of bid amounts of money of $(m-n+1)$ pieces of information except the bid amount of money of the information of which the displaying order has been decided, calculating a ratio of the bid amount of money of each of $(m-n+1)$ pieces over said sum of bid amounts of money of $(m-n+1)$ pieces information, deciding information of which the displaying order is an n -th rank based upon a probability proportional to magnitude of said ratio of the bid amount of money of each of $(m-n+1)$ pieces of information, and deciding the displaying order of information ranging from a first rank up to an n -th rank; and **(paragraph 0082 Once the normalized probability has been calculated, the market value of bid element amount 358 for a listing can now be calculated. That market value is calculated as the product of bid element amount 358, the intrinsic CTR for the contemplated position of the listing, and the normalized probability for the listing)**

a means for transmitting information to the terminal so that information is displayed in said decided displaying order.

Claim 2:

Meisel discloses the method of claim 1 and further discloses wherein:

said information providing system comprises:

a means for recording the number of times of display of each information in the terminal;

a means for recording the click number of each information displayed in the terminal;
and

a means for calculating a ratio of the click number to said number of times of display for each selected information; and said displaying order deciding means decides the displaying order of information based upon a probability that is calculated from a ratio of the bid amount of money of information over said sum of bid amounts of money and a ratio of the click number to said number of times of (0091)

Claim 3:

Claim 3 encompasses similar scope as claim 1, thus similar ground of rejection is applied.

Claim 4:

Meisel discloses the method of claim 4 and further discloses:

a means for recording the number of times of display of each information in the terminal; a means for recording the click number of each information displayed in the terminal; and

a means for calculating a ratio of the click number to said number of times of display for each selected information;

wherein said displaying order deciding means operates so that the displaying order of information is decided based upon a probability that is calculated from a ratio of the bid amount of money of information over said sum of bid amounts of money and a ratio of the click number to said number of times of display (paragraph 0024)

Claim 5:

Claim 5 encompasses similar scope as claim 3, thus similar ground of rejection is applied.

Claim 6:

Meisel discloses the method of claim 6 and further discloses wherein the information providing method according to claim 5, comprising:

recording the number of times of display of each information in a terminal and the click number of each information displayed in the terminal; and

deciding the displaying order of information based upon a probability that is calculated from a ratio of the bid amount of money of information over said sum of bid amounts of money and a ratio of the click number to said number of times of display (paragraph 0024).

Claims 19 and 20

Meisel discloses an advertisement information publishing system for providing advertisement information responding to a retrieval request from a terminal, comprising:

a database having advertisement information and a bid amount of money of said advertisement information stored correspondingly (paragraph 0026; **One embodiment of the system and method provides a database having accounts for the web site promoters. Each account includes contact and billing information for a web site promoter. In addition, each account includes at least one search listing, each search listing having five components:**

a selecting means for, responding to the retrieval request from the terminal, selecting advertisement information that becomes an object of display from said database;

an advertisement publishing order deciding means for deciding a publishing order of each advertisement information, being an object of display, based upon a probability that is calculated from a ratio of the bid amount of money of each of advertisement information that becomes an object of display over a sum of bid amounts of money of said advertisement information that becomes an object of display; and (paragraph 0027; **“ The market value of a bid is calculated as the sum of the market values of the elements of that bid. The market value of a bid element is calculated as the product of the amount of the bid element and the probability of the occurrence of the referral associated with that element).**

a means for transmitting advertisement information to the terminal so that an advertisement is displayed in said decided advertisement publishing order.

Response to Arguments

9. The applicant has argued in the response that the Meisel fails to disclose the steps of claim 1. Specifically, Applicant argues Meisel fails to disclose "continuously calculating a sum of bid amounts of money of (m-1) pieces of information except the bid amount of money of the information of which the displaying order is a first rank, calculating a ratio of the bid amount of money of each of (m-1) pieces of information over said sum of bid amounts of money of (m-1) pieces of information, and deciding information of which the displaying order is a second rank based upon a probability proportional to magnitude of said ratio of the bid amount of money of each of (m- 1) pieces of information; said computation is performed until information of which the displaying order is an (n-1)-th rank is decided; and calculating a sum of bid amounts of money of (m-n+1) pieces of information except the bid amount of money of the information of which the displaying order has been decided, calculating a ratio of the bid amount of money of each of (m-n+1) pieces over said sum of bid amounts of money of (m-n+ 1) pieces information, deciding information of which the displaying order is an n-th rank based upon a probability proportional to magnitude of said ratio of the bid amount of money of each of (m-n+ 1) pieces of information, and deciding the displaying order of information ranging from a first rank up to an n-th rank." Examiner partially agrees with the applicant. Meisel although discloses ranking based on the bid amount, Meisel fails to rank based on *ratio* of the bid amount against the *sum* of the bid amounts. Although, the end effect is similar (giving better probably to higher bid amount), Meisel does not disclose every step of Claim1. However, as discussed above, the claim is deemed confusing in parts (see 101 and 112 rejections above). The method claims are also deemed non-statutory. The examiner suggests the applicant to contact the examiner to conduct a formal interview.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MIN SHIN whose telephone number is (571)270-3463. The examiner can normally be reached on Mon-Fri 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weinhardt Robert can be reached on 571-272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS
1/15/2010
/Jean Janvier/
Primary Examiner, Art Unit 3688